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EXAMINER

HESS, DANIEL A

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,610

Applicant(s)

GRAHAM, MARTIN ALAN SCOTT

Examiner

Daniel A Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-21, 23, 25, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 22, 24 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of foreign priority based on AUSTRALIA PQ2737 dated 09/08/1999, a copy of which has been placed in the file of record.

### ***Remarks***

2. The examiner wishes to point out that the claims could be regarded as covering two separate inventions, similar to what is indicated in the 371 report. Nevertheless, this examiner is willing to address both sets of claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 23, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-7, 10, 11 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Szewcykowski (US 5,818,021).

Szewcykowski teaches a method of tracking documents such as bank notes having all of the elements and means as taught in claims 1-7, 10, 11 and 14-17. For example, Szewcykowski teaches the following:

Re claims 1-5 and 17: See figure 1: In step 7, the document is read for preexisting features / indicia. In steps 8 and 9, there is a comparison of scanned features with stored information in a database to see if features / indicia are authentic.

In steps 10 and 11, there is a signal granting clearance or denying clearance for a document.

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Re claim 6: It is clear that these are just broad descriptions of each of the necessary elements to achieve the steps discussed re claim 1 above. As for an indicator means, the phrase, 'security feature initiated' (column 4, lines 19-25) makes clear that some process occurs in the event of 'problem' notes. Since there is a human operator, they must somehow be made aware of this condition, in order to handle it properly. In this case of fraud, they must be notified.

Re claim 7: See step 11: 'Appropriate security procedures initiated.' Note also that in the case of Szewcykowski, the terminal *is* at the bank.

Re claim 10: See step 8, figure 1.

Re claim 11: The words 'any suitable communication means' is broad enough to cover anything Szewcykowski might use.

Re claim 14: See step 3.

Re claim 15: An RFID tag and a magnetic stripe are both employed (see abstract). These are probably located on two separate locations on the tag.

Re claim 16: See step 9: There is a comparison with previously stored notes / info.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 8, 9, 18, 19, 21, 25, 26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szewcykowski as applied to claim 1 above, in further view of Witschorik (US 6,131,718).

Re claim 8: Szewcykowski fails to show automatic transport of notes.

Witschorik shows (column 6, lines 55-60) the phrases 'inserts the bill' and 'responds to insertion' indicating transporting means.

The motive to include this is faster operation, and ease of use for the user.

Re claim 9: Szewcykowski has a magnetic stripe on the note. This implies a scanning head.

Re claim 18: Note that with the modification of claim 8, there is a system that takes in bills.

Further, it is known for banks to retain notes that are counterfeit.

One would be motivated to modify Szewcykowski to retain notes in order to keep that currency out of circulation and combating fraud.

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Re claim 19: It is understood in computing that a memory would be needed to temporarily store data during processing (i.e. RAM) and that this temporary memory is later overwritten (erased) by further data.

Re claim 21: See step 7: The number of times a note is scanned is recorded, and this value must be updated.

Re claim 25: See discussion re claim 1 above.

Re claims 26 and 28: See discussion re claim 18 above.

Re claim 29: See discussion re claim 19 above.

11. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Szewcykowski.

Although the scanner isn't explicitly hand-held, step 7 refers to the 'teller's scanner' and a handheld scanner would be equivalent in the art to another type of scanner that the teller might operate. In this case, the ability to hold the scanner in the hand is an aspect of form, not function. See in re Dillon.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Szewcykowski as modified by Witschorik as applied to claim 1 above, in further view of Strietzel (4,418,411).

Szewcykowski as modified by Witschorik fails to show recording of serial numbers.

Strietzel teaches (column 7, lines 25-50, esp. 39-42) that the serial number of a stored banknote is recording.

In view of Strietzel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known recording of serial numbers

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during storage because this can help combat fraud (column 7, lines 44-46) – ‘an alarm is released.’

***Allowable Subject Matter***

13. Claim 13 is allowed.

The examiner could not find within the art of record a teaching wherein a card is employment with note scanning such that the note can only be released when the card is placed in, or read by the a card reader associated with the receptacle, and wherein the scanned data is transferred to the card.

14. Claims 22, 24 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

See discussion re claim 13 above.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the



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organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

May 23, 2003

Daniel A Hess  
Examiner  
Art Unit 2876



**THIEN M. LE**  
**PRIMARY EXAMINER**